

Appl. No. 10/824,118
Docket No. 9209M
Amdt. dated November 17, 2008
Reply to Office Action mailed on July 16, 2008
Customer No. 27752

REMARKS

Claim Status

Claims 1-6, 12-16, and 18-23 are pending in the present application. Claims 18-21 were previously withdrawn. Claims 7 and 17 were previously canceled. Claims 8-11 and 24 are currently canceled. Claims 1, 13, 14, 22, and 23 are currently amended to overcome the instant rejection. Support for these amendments is found in Claim 11 (polydimethylsiloxane) and in the three examples in the specification (ratio). No additional claims fee is believed to be due.

Rejection Under 35 USC §103(a) Over Drechsler in view of Nichols

Claims 1-6, 8-16, and 22-24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drechsler *et al.*, U.S. Pat. No. 6,139,823 (hereinafter “Drechsler”) in view of Nichols, U.S. Pat. No. 6,010,709 (hereinafter “Nichols”). Of the rejected claims, Claims 18-21 are withdrawn and Claims 8-11 and 24 are canceled. Accordingly, Applicants respectfully disagree as to Claims 1-6, 12-16, 22, and 23.

The Office has not factually supported a *prima facie* case of obviousness¹; accordingly, the Office’s assertion of obviousness is deficient and Applicants request allowance of the pending claims. The four factual inquiries that are used to determine obviousness under 35 U.S.C. §103(a) are: 1. determining the scope and contents of the prior art, 2. ascertaining the differences between the prior art and the claims at issue, 3. resolving the level of ordinary skill in the pertinent art, and 4. considering objective evidence present in the application indicating obviousness or nonobviousness.² In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious³:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical “person of

¹ See MPEP 2142.

² *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

³ See *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983).

ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicants’ disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.⁴

Moreover, the cited references must teach or suggest all the claim limitations.⁵ If the Office does not prove a *prima facie* case of unpatentability, then, without more, the Applicant is entitled to the grant of the patent.⁶ Applicants respectfully assert that the Office Action fails to meet all of these criteria, and thus fails to make a *prima facie* case of obviousness under 35 USC §103.

Applicants’ “subject matter as a whole” is not rendered obvious because the combination does not teach or suggest all of the claim limitations of independent Claims 1, 22, and 23. The differences between the claimed subject matter and the Drechsler-Nichols combination are not such that the claimed subject matter “would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”⁷

The Office notes on page 3 of the Final Office Action that Drechsler, in claim 6, teaches “[m]odified silicones, specifically aminosilicones, i.e. the amino alkyl side of silicone.” The Office points out on page 5 that Drechsler does not teach that the topcoat composition is selected from aminosilicones, carboxy modified silicones, epoxy modified silicones and mixtures thereof. The Office alleges on page 6 that “[i]t would have been

⁴ MPEP § 2142; *See also Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593, 1595-96 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). “Inventions typically are new combinations of existing principles or features....The ‘as a whole’ instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole.”

⁵ *See, e.g., In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991).

⁶ *See In re Oetiker*, 977 F.2d 1443.

⁷ *See* 35 U.S.C. §103(a).

obvious to one of ordinary skill in the art at the time of the invention to practice a cosmetic composition containing modified silicones, diorganopolysiloxane polymer, organosiloxane resin, a volatile carrier, and a topcoat composition because DRECHSLER teaches it is within the skill of the art to use modified silicones to improve the luster or smear resistance of lip compositions and NICHOLS teaches it is within the skill in the art to have a cosmetic composition with a topcoat composition.” Applicants respectfully question where in Drechsler these claims are made – the Office does not reference specific portions of Drechsler, other than claim 6.

The Drechsler-Nichols combination does not teach or suggest a cosmetic composition comprising both a modified silicone and a diorganopolysiloxane polymer as Applicants claim. Applicants currently amend Claims 1, 22, and 23 to further clarify this invention. A person skilled in the art, after reading Drechsler and Nichols, would not have considered a cosmetic composition comprising “an anhydrous mixture of: (1) modified silicones selected from the group consisting of aminosilicones, carboxy modified silicones, epoxy modified silicones, and mixtures thereof; (2) an organosiloxane resin; and (3) a polydiorganopolysiloxane polymer; wherein the ratio of (1) to (3) is at least 1:1” as Applicants claim. Drechsler is based on a composition comprising an organosiloxane resin and a fluid diorganopolysiloxane having a limited viscosity. Applicants’ composition introduces the use of organo-modified silicone to modify the film properties to achieve more pleasurable feel, profound film resistance, and better gloss and shine.⁸ Applicants’ invention requires both polydiorganopolysiloxane and amino-, carboxy-, or epoxy-modified silicones –resulting in a blend of two differently functionalized silicones– whereas Drechsler does not teach or suggest the two components together. Further, Applicants require a ratio of modified silicones to polydiorganopolysiloxane of at least 1:1. The Drechsler-Nichols combination does not teach or suggest Applicants’ ratio.

In view of the foregoing, Applicants respectfully submit that Claims 1, 22, 23, and the claims depending therefrom are patentably distinct from the combined disclosures of Drechsler and Nichols. Reconsideration and withdrawal of the Section 103 rejection of record is requested.

⁸ Applicants’ Specification, Background.

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Conclusion

Applicants have made an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied references. In view of the foregoing, Applicants respectfully request entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims.

Respectfully submitted,

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By 
Signature

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